



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/951,832 10/16/97 LINA

C 06-2916.312

022775

QM32/0607

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EXAMINER

RUHL, D

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 06/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/951,832

Applicant(s)

LINA ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8, 13 and 22-25 is/are allowed.
- 6) ☐ Claim(s) 1-7, 16-21 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 43.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

The request filed on 1-29-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/951832 is acceptable and a CPA has been established. An action on the CPA follows.

The examiner notes the letter concerning the deposit account that was filed on 2-28-01. With respect to the IDS of 1-29-01 the German document 847475 has not been considered because no translation or statement of relevancy of what the reference discloses has been provided to the examiner. Stating that based on the figures the German document appears to disclose a suction device in communication with what may be a wound surface is not a statement of relevancy. This statement is speculation and assumption on applicant's part as to what the reference discloses and is not a proper statement of relevancy.

Applicant should take notice that the limitation of claim 26 concerning the percentage of interconnected cells has been treated in two manners (interpretations) and that is why the claim is rejected under 35 USC 102 and 35 USC 103.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7,16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, there is no antecedent basis for "the fluid connection". No connection has been claimed. The language "at least one interposed in the fluid connection between said canister and said pump" does not make

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sense to the examiner. It is not clear where the filter is interposed? Interposed is defined as "to be between" so what does the language "interposed (between) in the fluid connection between" mean? The examiner does not understand where the filter is claimed as being located.

With respect to claim 2, where is the filter located? The location of the filter in claim 1 is not clear but it appears that applicant is claiming the filter as being between the pump and the canister so how can the filter also be located within the canister? This is not clear. The examiner does not understand where the filter is claimed as being located.

With respect to claim 21, the language "resultant detection of tilting of said canister" is confusing. What does "resultant detection" mean? This is not clear to the examiner.

Correction of all of the above is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-6, 16, 18-21, 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Elson (5466229).

With respect to claim 26, Elson discloses a pad 24, tube 22, canister 12 and suction pump 14. The pad is disclosed as being made of open cell sponge (foam) material. See US patent 4,747,166 that has been incorporated by reference in the

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Elson reference. With respect to the claimed "at least 90% interconnecting cells", the examiner considers the pad of Elson to be 100% interconnected cells. The sponge is one piece and therefore the cells that make up the sponge are 100% connected. The pump, tube, pad, and canister are all in fluid communication with each other. The bacterial filter is 138. See column 10, lines 10-24. The pad is capable (is adapted) of being positioned as claimed. The first sensor is 144. The second sensor is 158. Both sensors are associated with the pump as claimed. The pressure transducer is 236 and is associated with the pump as claimed.

With respect to claims 1,2, Elson discloses a pad 24, tube 22, canister 12 and suction pump 14. The pad is disclosed as being made of open cell sponge (foam) material. See US patent 4,747,166 that has been incorporated by reference in the Elson reference. The pump, tube, pad, and canister are all in fluid communication with each other. The hydrophobic membrane filter is 138. The filter 138 defines a membrane and is disclosed as being "non wetting" (hydrophobic). See column 10, lines 10-24. The pad is capable (is adapted) of being positioned as claimed and is fully capable of applying negative pressure to a wound or whatever the pad is placed against. The pad of Elson is fully capable of the claimed functional language.

With respect to claim 3, the housing is 20.

With respect to claim 4, the canister is removably retained in a recess as claimed.

With respect to claim 5, see column 13, lines 33-42.

With respect to claim 6, Elson incorporates by reference patent no. 4747166 with respect to the material for the pad (column 13). Because of this Elson discloses a

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polymer foam with interconnecting cells (the expanded cellulose microcellular material with an open cell construction). Cellulose is a polymer.

With respect to claim 16, the sensor to detect when the canister is full is float 144. When float 144 rises with the fluid in the canister to indicate a full condition, switch 236 will shut off the pump vacuum. See column 10, lines 41-66.

With respect to claims 18-20, the tilt sensor is 158. It can detect a tilt of more than 45 degrees and the sensor is associated with the pump to stop operation of the pump as claimed.

With respect to claim 21, see column 11, lines 53-57 where Elson discloses the claimed limitation. Elson has a delay mechanism as is claimed.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elson.

Elson discloses the invention substantially as claimed. Elson does not specifically disclose that the sponge (foam) has at least 95% interconnecting cells. The examiner has reviewed the instant application and notes that having at least 95% interconnecting cells does not produce any unexpected result or solve any particular problem and the examiner concludes the percentage of interconnecting cells in the foam to be a matter of design choice. Elson obviously has some percentage of interconnected cells so claiming a percentage of interconnected cells does not patentably distinguish over Elson.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elson in view of Martin (4631061).

Elson discloses the invention substantially as claimed. Elson discloses that the liquid sensor that detects a full condition for the canister can be "electrical sensors which respond to contact by the liquid filling the container". Elson does not specifically disclose that these electrical sensors are capacitance sensors. Martin discloses a fluid collection system that uses capacitance sensors to indicate the level of liquid collected and to alert the user that a full condition has been reached. See column 4, lines 34-58. Martin discloses that the liquid level sensor can be a capacitance sensor (column 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Elson with capacitance sensors as disclosed by Martin so that the fluid level of the canister can be detected. Elson discloses the use of electrical sensors that respond to contact by fluid and providing a capacitance sensor (an electrical sensor that responds to contact by fluid) is considered obvious to one of ordinary skill in the art.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elson in view of Todd et al. (5437651).

Elson discloses the invention substantially as claimed. Elson does not disclose polyether foam with 95% interconnecting cells although Elson does disclose the use of a foam material. Todd discloses a fluid collection system that uses a pad 12 that is made from polyurethane foam. The examiner considers polyether foam and polyurethane foam to be the same thing. They are equivalents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the foam of Todd in the system of Elson so that fluid can be readily collected by the void space in the foam.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6142982.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the failure to claim elements from the patented claim is considered

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obvious and making the filter a bacterial filter is also considered obvious. Deletion of an element and its function is considered obvious to one of ordinary skill in the art. In the instant pending claim 1 applicant has simply failed to claim the dressing and the pressure detector that are claimed in the patented claim and this is considered obvious. The patented claim does not recite that the filter is a bacterial filter. The use of bacterial filters is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the filter of the patented claim a bacterial filter to prevent contamination of the vacuum source as well as making sure that bacteria is not released to the atmosphere by the vacuum source. Another reason a terminal disclaimer is required is to maintain common ownership of claims of overlapping scope, which is the situation at hand.

Allowable Subject Matter

Claims 8,13,22-25 are allowed.

Applicant's arguments filed 1-29-01 have been fully considered but they are not persuasive. With respect to the traversal of the rejection of claim 26, the above 102 and 103 rejections address claim 26 as amended and no further comments are warranted from the examiner. The examiner notes applicants comments concerning analogous art and notes that claims 1 and 26 have been rejected under 35 USC 102 and based on the statement by applicant that the doctrine of analogous art does not apply to 102 rejections the argument is found non-persuasive. With respect to the issue of analogous art in a general sense, the examiner again will stress that this issue is relevant to a secondary reference used in a 103 rejection and not the base reference. Elson is a suction device that suctions up fluids so how can applicant argue that it is not

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relevant to the instant pending article claims that claim a suction device that also suctions up fluids? Applicant should simply state what limitations are in the claims that the prior art does not disclose so that it is clear to the examiner what the novel limitations are. The arguments are found non-persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DR
May 31, 2001


DENNIS RUHL
PRIMARY EXAMINER